



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/752,227 | 12/29/2000 | Joseph E. Johnson | 97078CIPDIV1 | 5132 |

7590

10/06/2005

Cabot Corporation
Law Department
157 Concord Road
Billerica, MA 01821

EXAMINER

SHOSHO, CALLIE E

ART UNIT

PAPER NUMBER

1714

DATE MAILED: 10/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/752,227

Applicant(s)

JOHNSON ET AL.

Examiner

Callie E. Shosho

Art Unit

1714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 July 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 57-67, 70-72, 80, 82 and 84-86 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 86 is/are allowed.
- 6) ☒ Claim(s) 57, 59-62, 65-67, 80, 82, 84 and 85 is/are rejected.
- 7) ☒ Claim(s) 58, 63, 64 and 70-72 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

1. All outstanding rejections except for those described below are overcome by applicants' amendment filed 7/20/05.

Double Patenting

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 57, 59-62, 65-67, 80, 82, and 84-85 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 8-9, and 11-

Art Unit: 1714

14 of U.S. Patent No. 6,478,863 (Johnson et al.). Although the conflicting claims are not identical, they are not patentably distinct from each other because of the explanation given in paragraph 3 of the office action mailed 2/24/05 which is incorporated here by reference.

Response to arguments regarding Double Patenting

4. In response to the double patenting rejection of record, applicants filed a terminal disclaimer on 7/20/05.

However, the terminal disclaimer filed on 7/20/05 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of U.S. 6,478,863 has been reviewed and is NOT accepted.

Specifically, the person who signed the terminal disclaimer is not recognized as an officer of the assignee, and he/she has not been established as being authorized to act on behalf of the assignee. See MPEP § 324.

An attorney or agent, not of record, is not authorized to sign a terminal disclaimer in the capacity as an attorney or agent acting in a representative capacity as provided by 37 CFR 1.34

(a). See 37 CFR 1.321(b) and/or (c).

It is noted that it would be acceptable for a person, other than a recognized officer, to sign a terminal disclaimer, provided the record for the application includes a statement that the person is empowered to sign terminal disclaimers and/or act on behalf of the organization. Accordingly, a new terminal disclaimer which includes the above empowerment statement will be considered to be signed by an appropriate official of the assignee. A separately filed paper referencing the

previously filed terminal disclaimer and containing a proper empowerment statement would also be acceptable.

Allowable Subject Matter

5. Claim 86 is allowable for the reasons set forth in paragraph 9 of the office action mailed 2/24/05 which is incorporated here by reference.

6. Claims 58 and 63-64 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 58 and 63-64 would be allowable if rewritten in independent form for the reasons set forth in paragraph 10 of the office action mailed 2/24/05 which is incorporated here by reference.

7. Claims 70-72 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 70-72 would be allowable if rewritten in independent form as described above for the following reasons.

Sano et al. (U.S. 5,690,723) disclose ink jet ink comprising aqueous vehicle, polymer including copolymer obtained from styrene and acrylate, and pigment that is surface treated with resin. However, there is no disclosure in Sano et al. of specific modified pigment as presently

Art Unit: 1714

claimed. In order to meet the requirement in claims 70-72 regarding the pigment, Sano et al. was combined with either Cooke et al. (U.S. 6,110,994) or Hall et al. (U.S. 5,552,458)

Cooke et al. disclose modified pigment comprising pigment having attached group of the formula $\text{Ar-CO}_2\text{-R}$ where A is aromatic group corresponding to presently claimed X and R is polymer such as polyamide or polyester. However, there is no disclosure or suggestion that the polymer is polycarbonate, polyether, polyimide, polyurethane, or polyvinyl alcohol as required in present claims 70-72.

Hall et al. disclose modified pigment having attached group of the formula $\text{R}^2\text{-Si-A-X}$ wherein R^1 and R^3 are each $\text{C}_1\text{-C}_{10}$ alkyl group, A is divalent radical, and X is attached to polymeric backbone and wherein X is then reacted with reactive functionality on a polymer backbone so that the modified pigment comprises pigment with attached group that is substituted with polymer. The polymer includes polyurethane and polyester. However, the above attached group is attached to the pigment through -Si-O-M bonds where M represents surface metal on the pigment material such as aluminum, gold, copper, silver, etc. There is no disclosure or suggestion that the pigment has directly attached aromatic or alkyl group which is substituted with polymer as required in present claims 70-72. Rather, the attachment in Hall et al. is through -Si-O-M bond not aromatic or alkyl group.

Conclusion

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Callie E. Shosho whose telephone number is 571-272-1123. The examiner can normally be reached on Monday-Friday (6:30-4:00) Alternate Fridays Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on 571-272-1119. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1714

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Callie E. Shosho
Primary Examiner
Art Unit 1714

CS

10/1/05